

REMARKS

In the Final Office Action¹, the Examiner:

rejected claims 1-20 under 35 U.S.C. § 112, second paragraph as allegedly indefinite;

rejected claims 1-8, 10, 11, 13-18, 20, 21, and 23-32 under 35 U.S.C. § 102(b) as allegedly unpatentable over *B2B Collaborative Commerce with Sametime, QuickPlace and WebSphere Commerce Suite* authored by Nielsen ("Nielsen");

rejected claims 9, 19, and 22 under 35 U.S.C. § 103(a) as allegedly unpatentable over Nielsen in view of a web page news release entitled *United Nations and Oasis Join Forces to Produce Global XML Framework for Electronic Business* published by ebXML ("ebXML"); and

rejected claim 12 under 35 U.S.C. § 103(a) as allegedly unpatentable over Nielsen in view of Official Notice.

Claims 1-32 remain pending.

Applicant respectfully traverses the rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph. In the Final Office Action, the Examiner stated that "the Examiner is not clear what Applicant intends to claim a method or a computer-readable storage medium." Final Office Action at page 3.

Applicant submits that claim 1 is drawn to "[a] computer-readable storage medium comprising instructions, which when executed on a processor cause the processor to perform a method." Thus, Applicant is claiming a "computer-readable storage medium" that is characterized by the medium's performance of a "method." Thus, claim 1 is not indefinite.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

The M.P.E.P. in § 608.01(n) states “the fact that a dependent claim which is otherwise proper might relate to a separate invention which would require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim.” The M.P.E.P. continues stating

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim.

Applicant asserts that the rejection of claims 2-20 is improper under §608.01(n) of the M.P.E.P. because these claims are still proper whether they recite further elements of the claimed “computer-readable storage medium” or if they further characterize the claimed “computer-readable storage medium.” Applicant submits that each of the dependent claims further define patentable features of the claimed “computer-readable storage medium” or further characterize the medium’s performance of a “method.” Accordingly, claims 1-20 are definite and the rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

Applicant respectfully traverses the rejection to claims 1-8, 10, 11, 13-18, 20, 21, and 23-32 under 35 U.S.C. § 102(b). In order to properly establish that Nielsen anticipates Applicant’s claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236,

9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Nielsen does not anticipate the claims at least because it fails to teach, or even suggest, each and every element of the claims.

Claim 1 recites, among other features, “loading a business schema from a central repository via a schema module, the business schema being a predefined sequence of business transactions combined with documents that are assigned to the business transactions” (emphasis added). Nielsen does not disclose, or even suggest, at least this feature of claim 1.

Applicant notes that while the Final Office Action does not rely on a newly cited reference, it does rely on new reasoning to maintain the rejection of claim 1. The Final Office Action now asserts that Nielsen pages 44-45, Figure 34, page 225, Figure 7, and Figure 11, when taken together, combine to expressly disclose the claimed “loading a business schema from a central repository via a schema module, the business schema being a predefined sequence of business transactions combined with documents that are assigned to the business transactions.” Final Office Action at page 3.

Specifically, the Examiner alleges that in Nielsen “TECKCRAFT transactional B2B Web site where a buyer can browse the catalog, create requisition lists, issue an order (or reorder) (e.g., a predefined sequence of business transactions combined with documents) see status for current orders and participate in auctions and (page 26) Figure 11 which illustrates requisition lists (e.g., a document) of a buyer in order to perform a business transaction (e.g., issue an order or reorder)” discloses the above cited element of claim 1. *Id.* This new interpretation of Nielsen is, however, incorrect.

Even if browsing a catalog, creating requisition lists, issuing an order, seeing a status for an order, or participating in auctions can be considered “business

transactions,” which they cannot, showing association of a document with a “business transaction” is not enough to disclose the claimed features. For example, the “business schema” in claim 1 is a “predefined sequence of business transactions combined with documents that are assigned to the business transactions.” Not only does Nielsen fail to disclose “documents that are assigned to business transactions,” the only document that the Final Office Action even alleges to exist in Nielsen is a “requisition list.” Final Office Action pages 3-4. There is nothing about “browsing a catalog, issuing an order, or participating in auctions” in Nielsen that requires a document by virtue of the “browsing. . . , issuing. . . , or participating.” Even if in Nielsen “creating requisition lists” requires a document, “creating requisition lists” cannot constitute a business transaction because “creating a requisition list” is only creating a list of goods and is not itself a transaction for goods.

Furthermore, Nielsen does not disclose or suggest the claimed “predetermined sequence of business transactions.” The Final Office Action has not shown that Nielsen describes “business transactions” are organized in “a predefined sequence” merely by the Final Office Alleging alleging that “a buyer can browse the catalog, create requisition lists, [and] issue an order.” Final Office Action at page 3. Nothing here discloses that there is even a “sequence” in Nielsen much less a “predetermined sequence.”

In sum, there is no disclosure in Nielsen that can constitute the claimed “a predefined sequence of business transactions.” Furthermore, it cannot be said that any “predetermined sequence of business transactions” in Nielsen are “combined with documents that are assigned to the business transactions” at least because there is no disclosure in Nielsen of documents that are actually assigned to the “business

transactions” much less that there are documents assigned to the “predetermined sequence of business transactions.”

For at least these reasons, the Office Action has failed to demonstrate each and every element of each of independent claim 1. Independent claims 21, 23, and 25, while of different scope, recite elements similar to those of claim 1 and are thus allowable over the references for at least the reasons similar to those discussed above in regard to claim 1. Dependent claims 2-8, 10-11, 13-18, 20, 23-24, and 26-32 are allowable at least due to their dependence on one of claims 1, 21, 23, or 25. Applicant therefore request that the rejection of claims 1-8, 10-11, 13-18, 20-21, and 23-32 be withdrawn.

Applicant respectfully traverses the rejection of claims 9, 12, 19, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Nielsen in view of either ebXML or Official Notice.

Claims 9, 12, 19, and 22 depend from independent claims 1 or 21 and thus include all elements of claim 1 or 21. As discussed above, Nielsen does not teach, suggest, or render obvious each and every element recited in claims 1 and 21. Neither ebXML nor Official Notice remedy the deficiencies of Nielsen. Claims 9, 12, 19, and 22 are therefore also allowable for reasons at least similar to those presented above for claim 1. Accordingly, for at least the above-noted reasons, Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejections of claims 9, 12, 19, and 22.

With regard to claim 12, the Final Office Action asserts that there are minimum requirements to challenge Official Notice. Final Office Action at page 4. But, the Final Office Action does not provide a reference citation for these minimum requirements.

The M.P.E.P. in section 2144.03 (A) states "assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." Here, the Examiner claims specific knowledge of the prior art by stating that claim 12 is "old and well known." Final Office Action at page 23. Therefore, per M.P.E.P. section 2144.03 (A), Applicant requests that the Examiner provide documentary evidence to support each assertion of Official Notice. Absent documentary evidence, the Office Action has failed to make a *prima facie* case of obviousness regarding dependent claim 12. Accordingly, the rejection of claim 12 should be withdrawn.

CONCLUSION


In view of the foregoing, Applicant respectfully requests reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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